

Mitchell, David

From: Mitchell, David
Sent: Monday, November 06, 2000 6:16 PM
To: Terapane, John; Bagnell, David; Braun, Leslie; Browne, Lynne; Bucci, David; Carone, Michael; Cuchlinski, William; Cuomo, Peter; Dayoan, BethAnne; Dayoan, Glenn; Dornier, Kenneth; Ellis, Christopher; Friedman, Carl; Johnson, Brian L.; Jordan, Charles; Knight, Anthony; Lillis, Eileen; Mai, Lanna; Marmor, Charles A. (AU 3681); Melius, Terry; Meyers, Steven; Mitchell, David; Morano, Samuel; Oberleitner, Robert; Olszewski, Robert; Poon, Peter; Reese, Randolph; Stodola, Daniel; Swann, Judy; Tarcza, Thomas; Terrell, William; Walsh, Donald; Will, Tom; Adams, Effie; Bradshaw, Theresa; Brown, Joyce; Graham, Arlene; Hawkins, Pauline; Ross, Shanda; Smith, Juanita; Hodge, Joanne; Waldo, Jackie; White, Geneva
Cc: Terapane, John; Goldberg, Gerald; Smith, Al
Subject: FW: BPAI Returns when No Appeal Conference Indicated

I have had several inquiries and discussions about the TC Appeal Conference Policy in view of the recent memo from Steve Kunin on the need for conferee initials on the last page of the Examiner's Answer. The TC Policy need not be changed and is in conformance with the Kunin memo. Specifically, it is only necessary that the printed initials of the conferee be placed on the last sheet of Examiner's amendment. No handwritten initials or signature for the conferees are required. This position is verified from the office of the Deputy Commissioner for Patent Examining Policy as can be seen by the string of e-mails attached.

-----Original Message-----

From: Terapane, John
Sent: Thursday, October 26, 2000 11:27 AM
To: Mitchell, David
Cc: Goldberg, Gerald; Smith, Al
Subject: FW: BPAI Returns when No Appeal Conference Indicated

Looks like we are OK

-----Original Message-----

From: Greenlief, Magdalen
Sent: Thursday, October 26, 2000 10:15 AM
To: Terapane, John
Subject: RE: BPAI Returns when No Appeal Conference Indicated

A revised appeal conference memo was sent to the TC Directors on Wednesday, 10/25. The 3/20/2000 memo was revised to incorporate the review-return procedures by the Board as suggested by Al Smith and agree upon by Bruce Stoner.

The issue of who may participate in the appeal conference was left to the discretion of the TC. Therefore, your TC's preference is consistent with Steve's memo. As to the issue of printing or writing the initials of the conferee, Steve's memo does not require written initials. The memo states that the name of the conferee and an indication that the person is a conferee along with his/her initials must appear in the examiner's answer below the name of the examiner who prepared the examiner's answer. Written or typed initials are acceptable.

The MPEP will be revised accordingly in the upcoming revision to incorporate the substance of the revised appeal conference memo.

-----Original Message-----

From: Terapane, John
Sent: Thursday, October 26, 2000 8:34 AM
To: Greenlief, Magdalen
Subject: FW: BPAI Returns when No Appeal Conference Indicated

Magdalen-

Our process works well, but as Dave notes it differs from Steve's memo. Because the goals are the same-a conference in every appealed case, we like our procedure of printing the initials on the last page, and not requiring written initials. Hopefully, the MPEP and Board processing can be such that this is sufficient. Regarding who may

Answer, the Examiner would likely not feel a sense of urgency in resolving the matter of the absence of the Conferees initials, or in conducting an Appeal Conference if one had not been conducted. In order to avoid having these returned cases fall through the cracks, It is expected that Examiner's Answers returned by the BPAI directly to the Group Directors' offices will be logged in and monitored by the Directors' Secretaries, and that their return to the BPAI will be expedited by the Directors. The return of such cases directly to the Group Director will also serve as a means to assess and enforce compliance with the requirement for Appeal Conferences.

AI.....

-----Original Message-----

From: Smith, Al
Sent: Monday, October 09, 2000 4:45 PM
To: Patent Directors
Subject: BPAI Returns when No Appeal Conference Indicated
Importance: High

Since the WIL Meeting has again been canceled, I would appreciate your input on the following **by cob today, Tuesday**, so I can reflect our wishes at the POC meeting on Wednesday, so Nick, Esther and Steve can consider our wishes and respond to Bruce Stoner's request. Bruce has submitted to Steve, the following observation, with a request for cooperation and guidance:

Steve,

It is my understanding that appeal conferences have been mandatory in all TCs for several months now, although the most recent version of the MPEP (7th edition, revision 1) doesn't appear to reflect the mandatory nature of appeal conferences.

My understanding is that the conferees initials are to appear on the signature page with an indication that a conference has been held. I am considering instructing BPAI personnel to return to the TC any appeal received on or after Oct. 1, 2000 (that is, appeals in the 2001-XXXX series) not bearing an indication that an appeal conference has been conducted. Obviously, that date is not cast in stone - this could be implemented later, if appropriate. Is it premature for the BPAI to undertake such an action? Is there some unequivocal indication each case which has had a conference bears so that we can return only those which have not had a conference?

Assuming we decide to do this, another concern is the form such a return should take. We try not to part with any case in which an appeal number has been assigned without entering a remand. We could likewise return these appeals by remand, although that might inflate the remand numbers for some time. Alternatively, we could simply review each appeal as it comes in the door, prior to assigning an appeal number, and return the file to the group without assigning an appeal number. Which form of return would be best from Patents' standpoint?

I'd appreciate having your thoughts on both of the highlighted matters.

Bruce

Of course, Bruce is correct in his understanding that Appeal Conferences are mandatory in the Corps; and given the number of BPAI proceedings that have been obviated via the Appeal Conference process, it is appropriate and reasonable that he would like to see some indication that an Appeal Conference was held in each case coming before the Board.

In my view, it would be better if the BPAI would:

- (1) review each appeal as it comes in the door, prior to assigning an appeal number;
- (2) if the Examiner's Answer does not contain the indication that an Appeal Conference has taken place (i.e., the word Conferees appearing below the Primary Examiner's Signature, followed by the initials of the conferees at least typed or printed), return the file to the TC Director's office; and
- (3) apply this review and return procedure to any Examiner's Answer received by them beginning on November 1, 2000.

If you agree with my proposal, just so indicate. If you have a different proposal, or any modifications to the one I have presented above, please spell it out along with reasons.

along with his/her initials below those of the examiner who prepared the answer. The memo further stated that the Board of Appeals and Interferences should return the case to the examining corps if no appeal conference was held. The memo also noted that the MPEP will be revised accordingly in the upcoming revision to reflect this procedure.

According to Al Smith's message below, the Group Directors want to have the cases returned directly to the Group Director's Office and be logged in and monitored if an appeal conference has not been held. This will be incorporated into the MPEP in the upcoming revision.

-----Original Message-----

From: Kunin, Stephen
Sent: Monday, October 23, 2000 8:54 AM
To: Antonakas, Manuel; Greenlief, Magdalen; Knoblock, Judy; Lacey, David; Pearson, Charles; Ramdat, Grace; Saifer, Robert; Spar, Bob; Therkorn, Linda
Subject: FW: BPAI Returns when No Appeal Conference Indicated
Importance: High

MPEP change?

Stephen G. Kunin

Deputy Commissioner for Patent Examination Policy
United States Patent & Trademark Office

-----Original Message-----

From: Smith, Al
Sent: Friday, October 13, 2000 2:00 PM
To: Kunin, Stephen
Cc: Godici, Nicholas; Kepplinger, Esther; Patent Directors
Subject: BPAI Returns when No Appeal Conference Indicated
Importance: High

Steve, about half of the Directors forwarded written comments responsive to the request for any input presented below.

The matter was also discussed at the AC/Patents Staff meeting yesterday. There is a clear consensus on the following recommendation:

- (1) *The BPAI should review the Examiner's Answer in each appeal as it arrives at the BPAI, prior to assigning an appeal number;*
- (2) *If an Examiner's Answer does not contain the appropriate indication that an Appeal Conference was conducted (specifically, the word Conferees appearing below the Primary Examiner's signature, followed by the initials of the conferees at least typed or printed), the BPAI should return the file directly to the office of the TC Director, but not as a remand; and*
- (3) *This review-and-return procedure should be applied to any Examiner's Answer received by the BPAI beginning on November 1, 2000.*

The only comments received from the Directors, beyond their agreement with the process recommended above, related to (a) the possibility that Appeal Conferences are not being conducted in all cases in spite of the emphasis placed on this requirement by the Group Directors, and (b) the potential for adverse impact on term extensions if appeals that have been returned from the BPAI are not closely monitored and returned promptly to the BPAI.

Re (a): CAPJ Bruce Stoner's comment noting the absence from the MPEP of the "mandatory" nature intended in the policy regarding an Appeal Conference, coupled with the fact that there is no "written" directive from the AC or DAC level mandating Appeal Conferences, lends credence to the possibility that some Primary Examiners might feel that it is optional. It is suggested that the MPEP be modified to reflect that Appeal Conferences are "mandatory," and that a memorandum be sent out to the Corps from the AC's or DAC's office stating that Appeal Conferences are "mandatory."

Re (b): Since the Examiner will have already received credit, i.e., a productivity count, for the Examiner's

participate in the conference, there is no conflict as our preferences fit within the guidelines of Steve's memo.

-----Original Message-----

From: Mitchell, David
Sent: Tuesday, October 24, 2000 11:19 AM
To: Terapane, John
Cc: Goldberg, Gerald; Smith, Al
Subject: RE: BPAI Returns when No Appeal Conference Indicated

The Kunin memo of 3/20/00 differs from our group Policy on Appeal conferences slightly but significantly. Our TC policy requires the examiner in charge of the cases and two conferees. The Kunin memo only suggests people that the conference "may include". Our TC policy is also more specific and more understanding of case flow and handling procedures, with respect to the actual indication on the last sheet of the Answer that a conference was held. Our policy only requires the word "conferees" followed by the printed conferees' initials. Kunin's memo would require the name followed by written initials.

Of course our TC policy is better and accomplishes the desired result without the hassles imposed by Kunin's memo. The examiner in charge in our TC would not have to move the case around among all the conferees to get their initials before sending the case off. Also the conferees would not feel that by adding their initials they necessarily agree with how things were said in the conference or even its final result. After all the Primary Examiner makes the final decision.

We can modify our TC policy slightly to conform, or we can leave ours as is and simply insure that the Board understands that our cases will not have handwritten initials adjacent the conferees. This second course seems best to me, but we would also need to input the change process for the MPEP to make sure that what's said there would not prevent our TC policy.

Also, I am surprised that the Directors agreed to let the Board do our housekeeping for us. Of course there is no Rule or other authority which would enable the Board to Remand cases or even expect to see cases with "conferees" on them. I do not feel that the Board should be asked to look for cases which do not conform with our internal Examining corps policies. Actually I feel they already have an attitude of finger shaking at the Corps for other difficulties. With this practice we could give them some real data. So, let's institute our own practices here in the TC so that the Board doesn't get the opportunity to return cases to us.

I propose we devise a process whereby before the case leaves the TC, someone checks to make sure a conference has been held and indicated. Already it is typical and required that the Applications clerk check to verify that the answer is signed. (There are check lists which include this and a lot of other checks specifically for Examiners Answers.) An additional check to see that "conferees" or "conference" is on the same sheet as the signature, would be a simple matter. If not there, the case would go to the SPE.

-----Original Message-----

From: Terapane, John
Sent: Monday, October 23, 2000 3:14 PM
To: Bagnell, David; Bianco, Jill; Braun, Leslie; Browne, Lynne; Bucci, David; Carone, Michael; Cuchlinski, William; Cuomo, Peter; Dayoan, BethAnne; Dayoan, Glenn; Dorner, Kenneth; Ellis, Christopher; Falk, Joe; Friedman, Carl; Goldberg, Gerald; Hodge, Joanne; Johnson, Brian; Jordan, Charles; Knight, Anthony; Lillis, Eileen; Mai, Lanna; Manley, Arnitra; Marmor, Charles; Melius, Terry; Meyers, Steven; Mitchell, David; Morano, Samuel; Oberleitner, Robert; Olszewski, Robert; Poon, Peter; Reese, Randolph; Samuels, James; Smith, Al; Stodola, Daniel; Swann, Judy; Tarcza, Thomas; Terrell, William; Waldo, Jackie; Walsh, Donald; White, Geneva; Wildermuth, Donna; Will, Tom
Subject: FW: BPAI Returns when No Appeal Conference Indicated
Importance: High

-----Original Message-----

From: Greenlief, Magdalen
Sent: Monday, October 23, 2000 11:19 AM
To: Patent Directors; Stoner, Bruce
Cc: Godici, Nicholas; Kepplinger, Esther; Kunin, Stephen
Subject: FW: BPAI Returns when No Appeal Conference Indicated
Importance: High

<< File: appeal-conf-memo-3-20-00.doc >>

FYI

Attached above is a copy of a memo signed by Steve Kunin and dated March 20, 2000 regarding appeal conferences. The memo was addressed to the patent examining corps notifying them that appeal conferences are mandatory. The memo stated that in order to make the record clear that an appeal conference has been held, the conferee of the appeal conference must place his/her name and identify himself/herself as the conferee

Please respond by cob today, Tuesday.

Thanks,

Al.....